

REMARKS

The above-identified application has been considered in view of the Office Action that was mailed on March 18, 2008. Claims 12-17, 19-21, 23-25, and 32-36 are currently pending. By the present Amendment, Applicant has amended claims 32-33 and 35-36. Applicant respectfully submits these amendments incorporate no new matter and are fully supported by the specification, and that the pending claims are allowable over the cited references of record. Applicant respectfully requests reconsideration and allowance of the above-identified application.

Claims 24 and 25 were rejected under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement. In particular, the Examiner asserted that there is no basis in the specification for the recitation of an elongate tubular member formed of a rigid material, noting in particular page 9 of the specification at lines 3-6, and page 7 of the specification at line 9.

The specification discloses, at least on page 6, that “[a] most typical construction for the cannula and/or retractor of the present invention is an inflatable bladder situated on the end of a shaft, which may be flexible or rigid.” (Emphasis added). Accordingly, Applicant respectfully submits that the recitation of an elongate tubular member “formed of a rigid material” in claims 24-25 is fully supported by the specification and in compliance with the requirements of 35 U.S.C. § 112, first paragraph, and respectfully requests withdrawal of the rejection of claims 24-25 under 35 U.S.C. § 112, first paragraph.

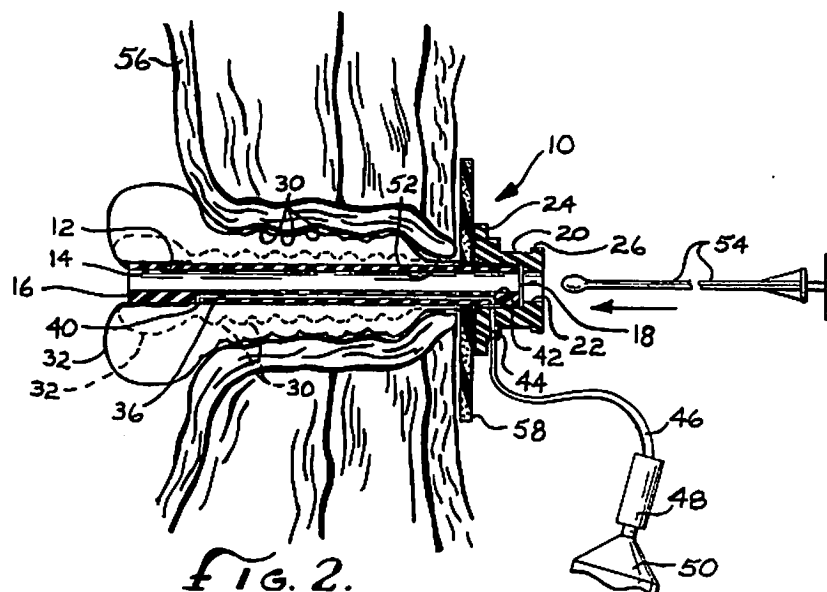
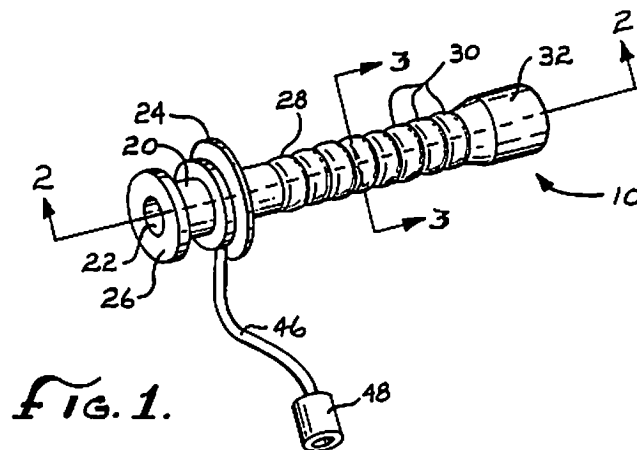
Claims 24-25, 32-33, and 35-36 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With respect to claims 24-25, the Examiner asserted that the language of these claims is confusing and inaccurate since the specification indicates that the elongate tubular member is flexible, and not rigid. Applicant respectfully submits that the Examiner has confused disclosure relating to the cannula through which the elongate tubular member is inserted, and to cannulas in general, with disclosure relating to the elongate tubular member itself. As discussed above, the specification clearly states that the shaft may be rigid, at least on page 6 at lines 7-8. Accordingly, Applicant respectfully submits that language of claims 24-25 is not confusing or inaccurate, that the subject matter recited in claims 24-25 is fully supported by the specification, and that claims 24-25 are in compliance with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 24-25 under 35 U.S.C. § 112, second paragraph.

Regarding the rejection of claims 32-33 and 35-36, the Examiner argued that the claimed “at least two wall segments” had already been positively recited in claims 12 and 34, from which claims 32-33 and 35-36 respectively depend, and therefore, that the language of claims 32-33 and 35-36 is unclear. To remedy any confusion, Applicant has amended claims 32-33 and 35-36 herein. Applicant respectfully submits that the amendments to claims 32-33 and 35-36 require no further search and do not necessitate any further examination, as they are substantially clerical in nature. Applicant respectfully submits that the language of amended claims 32-33 and 35-36 is not confusing or inaccurate, that the subject matter recited in claims 32-33 and 35-36 is fully supported by the specification, and that claims 32-33 and 35-36 are in compliance with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 32-33 and 35-36 under 35 U.S.C. § 112, second paragraph.

Claims 12-16, 19-20, 24-25, and 32-33 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,555,242 to Saudagar (hereinafter "Saudagar"). However, Applicant respectfully submits that Saudagar fails to disclose each and every element recited in claims 12-16, 19-20, 24-25, and 32-33.

Saudagar discloses a drainage appliance including a tube 12, and an inflatable balloon 28 that is formed around the tube 12. (See col. 3, lines 41-53). As seen below in FIGS. 1 and 2, the balloon 28 includes a tubular portion having a plurality of circumferential ribs or corrugations 30. (See col. 4, lines 6-8).



The Examiner characterized the corrugations 30 as the “plurality of wall segments” recited in independent claims 12 and 19, and asserted that the “plurality of wall segments” includes at least two wall segments in an abutting relationship. Applicant respectfully submits, however, that the Examiner’s characterization of the corrugations 30 is erroneous. The corrugations 30 do not constitute or define individual, separate wall segments. Rather, the corrugations 30 are merely indentations or depressions formed on the single inflatable balloon 28 disclosed in Saudagar.

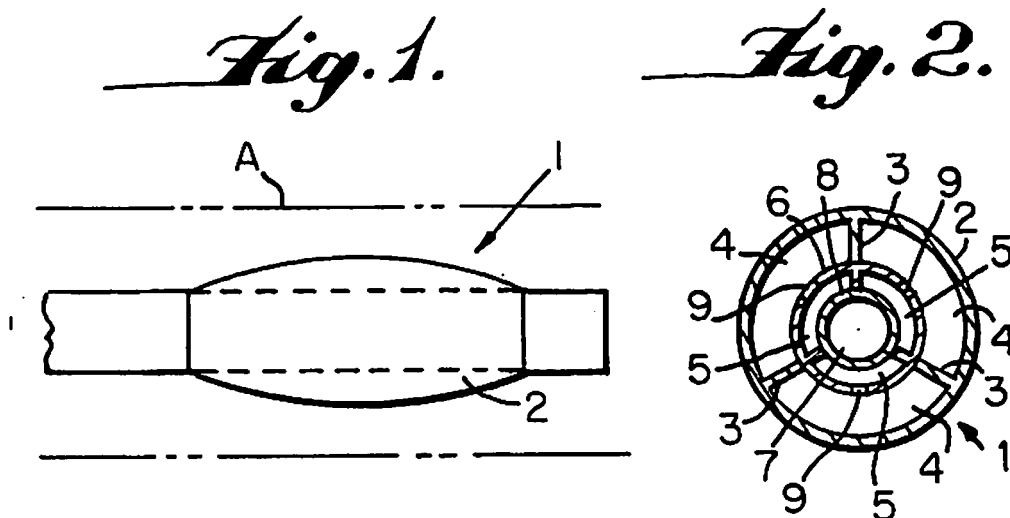
Accordingly, Applicant respectfully submits that Saudagar fails to disclose a surgical device that includes an elongate tubular member and “a plurality of wall segments disposed on said tubular member, each wall segment having an uninflated state and an inflated state” as recited in independent claims 12 and 19, disclosing instead only a single inflatable balloon. (Emphasis added). *A priori*, Applicant further submits that Saudagar also fails to disclose “at least two wall segments in an abutting relationship when in the uninflated state” as also recited in independent claims 12 and 19. (Emphasis added).

For at least these reasons, *inter alia*, Applicant respectfully submits that Saudagar fails to disclose each and every element recited in independent claims 12 and 19, and therefore, that independent claims 12 and 19 are allowable over Saudagar under 35 U.S.C. § 102(b). As claims 13-16, 20, 24-25, and 32-33 depend either directly or indirectly from independent claims 12 and 19 and include each element recited therein, for at least the reasons that independent claims 12 and 19 are allowable over Saudagar under 35 U.S.C. § 102(b), *inter alia*, Applicant respectfully submits that claims 13-16, 20, 24-25, and 32-33 are also allowable over Saudagar under 35 U.S.C. § 102(b).

Claims 12-13, 16-17, 19-21, 24-25, and 34-36 were rejected under 35 U.S.C. §102 (b) as

being anticipated by U.S. Patent No. 5,308,323 to Sogawa *et al.* (hereinafter "Sogawa"). However, Applicant respectfully submits that Sogawa fails to disclose each and every element recited in claims 12-13, 16-17, 19-21, 24-25, and 34-36.

Sogawa discloses a catheter 1 including a balloon 2 used to occlude a vessel, e.g., a blood vessel. (See col. 2, lines 33-36). The balloon 2 includes several internal compartments 4 divided by radial walls 3, as seen below in FIGS. 1 and 2. (See col. 2, lines 36-38).



The Examiner characterized the radial walls 3 as the plurality of wall segments recited in independent claims 12, 19, and 34. The radial walls 3, however, merely serve to divide the balloon 2 into several internal compartments. The balloon 2 is the only inflatable member included on the shaft of the catheter 1 disclosed in Sogawa.

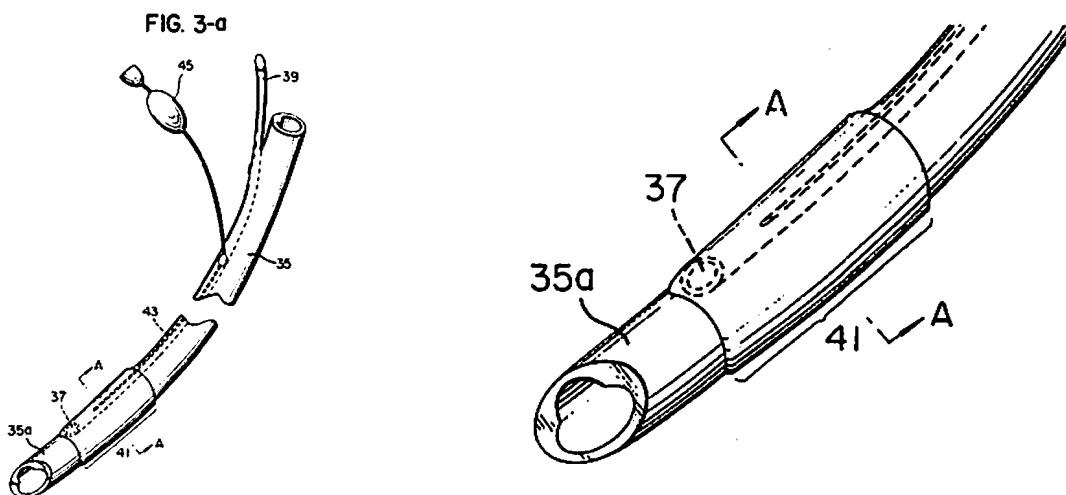
Accordingly, Applicant respectfully submits that Sogawa fails to disclose a surgical device including an elongate tubular member and "a plurality of wall segments disposed on said tubular member, each wall segment having an uninflated state and an inflated state" as recited in independent claims 12 and 19, or "a plurality of selectively inflatable wall segments disposed along the tubular member" as recited in independent claim 34, disclosing instead only a single balloon. (Emphasis added). *A priori*, Applicant further submits that Sogawa also fails to

disclose “at least two wall segments in an abutting relationship” as also recited in independent claims 12, 19, and 34. (Emphasis added).

For at least these reasons, *inter alia*, Applicant respectfully submits that Sogawa fails to disclose each and every element recited in independent claims 12, 19, and 34, and therefore, that independent claims 12, 19, and 34 are allowable over Sogawa under 35 U.S.C. § 102(b). As claims 13, 16-17, 20-21, 24-25, and 35-36 depend either directly or indirectly from independent claims 12, 19, and 34 and include each element recited therein, for at least the reasons that independent claims 12, 19, and 34 are allowable over Sogawa under 35 U.S.C. § 102(b), *inter alia*, Applicant respectfully submits that claims 13, 16-17, 20-21, 24-25, and 35-36 are also allowable over Sogawa under 35 U.S.C. § 102(b).

Claims 12-16, 19-20, and 23-25 were rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent No. 4,453,545 to Inoue (hereinafter “Inoue”). However, Applicant respectfully submits that Inoue fails to disclose each and every element recited in claims 12-16, 19-20, and 23-25.

Inoue discloses an endotracheal tube 35 including a cuff 41 near an end 35a thereof that is inflatable through blowing means 45, as seen below in FIG. 3-a. (See col. 3, lines 12-21).



The Examiner characterized the inflatable cuff 41 as the plurality of wall segments recited in independent claims 12 and 19, asserting that the cuff 41 can be considered to be made up of a plurality of wall segments which are joined together. The cuff 41 constitutes a single inflatable element only, as seen above in FIG. 3-a and the corresponding enlargement, and cannot be analogized to the “plurality of wall segments” recited in independent claims 12 and 19 and seen below in FIG. 35.

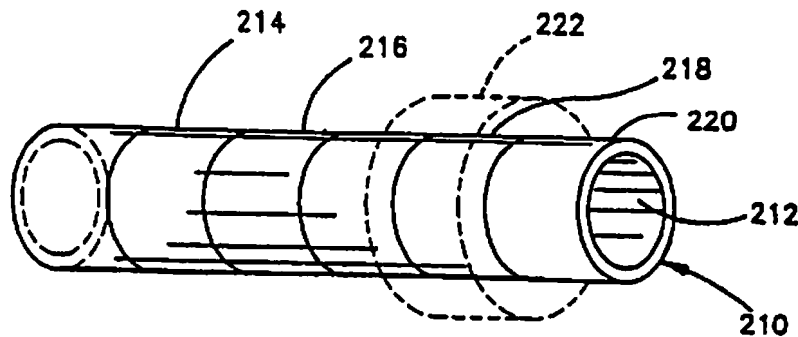


Fig.35

Accordingly, Applicant respectfully submits that Inoue fails to disclose a surgical device that includes an elongate tubular member and “a plurality of wall segments disposed on said tubular member, each wall segment having an uninflated state and an inflated state” as recited in independent claims 12 and 19, disclosing instead only a single inflatable balloon. (Emphasis added). *A priori*, Applicant further submits that Inoue also fails to disclose “at least two wall segments in an abutting relationship when in the uninflated state” as also recited in independent claims 12 and 19. (Emphasis added).

For at least these reasons, *inter alia*, Applicant respectfully submits that Inoue fails to disclose each and every element recited in independent claims 12 and 19, and therefore, that independent claims 12 and 19 are allowable over Inoue under 35 U.S.C. § 102(b). As claims 13-16, 20, and 23-25 depend either directly or indirectly from independent claims 12 and 19 and

include each element recited therein, for at least the reasons that independent claims 12 and 19 are allowable over Inoue under 35 U.S.C. § 102(b), *inter alia*, Applicant respectfully submits that claims 13-16, 20, and 23-25 are also allowable over Inoue under 35 U.S.C. § 102(b).

Claims 34-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,849,001 to Oddo (hereinafter "Oddo '001") in view of U.S. Patent No. 2,849,002 to Oddo (hereinafter "Oddo '002"). However, Applicant respectfully submits that the combination of Oddo '001 and Oddo '002 fails to suggest each and every element recited in claims 34-36.

Oddo '001 discloses a catheter including a tubular body portion defining a central drainage channel . (See col. 2, lines 10-12). The catheter further includes two inflatable balloons integrally mounted on the body portion . (See col. 2, lines 15-19).

The Examiner characterized the tubular body portion, the drainage channel, and the inflatable balloons as the elongate tubular member, the passage extending therethrough, and the inflatable wall segments recited in independent claim 34, respectively. However, the Examiner acknowledged that Oddo '001 fails to disclose that the balloons may be selectively inflated, as recited in independent claim 34, and relied on Oddo '002 for disclosure of that concept.

Oddo '001 states that the central drainage channel "is closed at the distal end." (Col. 2, line 12) (emphasis added). Accordingly, the channel does not extend through the tubular body portion, but rather, merely within the body portion. Oddo '001 further states that the catheter is insertable through the urethra such that the distal end of the tubular body portion extends into the bladder. (See col. 2, lines 58-60). Were the central drainage channel to extend completely through the tubular body portion such that the distal end was open, rather than closed, the surface area of the distal end of the tubular portion, i.e., the surface areas of the portion of the catheter contacting the patient's tissue upon insertion into the urethra, would be increased. Additionally,

including an open distal end would detract from the catheter's ability to divaricate the opening of the urethra, as well as the channel it defines, thereby frustrating advancement of the catheter into the bladder. As such, including an open distal end would likely increase patient discomfort while frustrating the catheter's use. Accordingly, Applicant respectfully submits that Oddo '001 does not disclose "an elongate tubular member defining a passage therethrough" as recited in independent claim 34, or even suggest that such would be desirable, in fact teaching away from a tubular member having an open distal end. (Emphasis added).

Moreover, the drainage channel extending within the tubular body portion defines a minimal internal dimension sufficient for the communication of fluid. The channel is not "configured to receive an operating tool" as also recited in independent claim 34.


Accordingly, Applicant respectfully submits that Oddo '001 fails to disclose or suggest a surgical device including "an elongate tubular member defining a passage therethrough that is configured to removably receive an operating tool" as recited in independent claim 34. (Emphasis added). Including the selectively inflatable balloons purportedly disclosed in Oddo '002 would fail to cure the deficiencies of Oddo '001.

For at least these reasons, *inter alia*, Applicant respectfully submits that the combination of Oddo '001 and Oddo '002 fails to suggest each and every element recited in independent claim 34, and therefore, that independent claim 34 is allowable over Oddo '001 in view of Oddo '002 under 35 U.S.C. § 103(a). As claims 35-36 depend either directly or indirectly from independent claim 34 and include each element recited therein, for at least the reasons that independent claim 34 is allowable over Oddo '001 in view of Oddo '002 under 35 U.S.C. § 103(a), *inter alia*, Applicant respectfully submits that claims 35-36 are also allowable over Oddo '001 in view of Oddo '002 under 35 U.S.C. § 103(a).

In view of the amendments to the claims effected herein and the foregoing remarks, Applicant respectfully submits that the above-identified application is in condition for allowance. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor

Respectfully submitted,



Dana A. Brussel
Reg. No. 45,717
Attorney for Applicant

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
Tel.: (631) 501-5713
Fax: (631) 501-3526

Send correspondence to:
Chief Patent Counsel
Covidien
60 Middletown Road
North Haven, Connecticut 06473